

REMARKS

Applicant is in receipt of the Office Action mailed September 15, 2003.

In amended Figures 1 and 5, the legend "Prior Art" has been added.

Claims 89-134 remain in this application. Claims 94 and 116 have been amended to correct the antecedent basis error objected to in the Office Action. Claims 89, 111, 133, and 134 have been amended to correct an antecedent basis error regarding inappropriate use of indefinite articles in reference to previously presented terms (the client system).

Further examination and reconsideration of the presently claimed application is respectfully requested in light of the following remarks.

Section 103 Rejections

In the Office Action, claims 89-98, 100-103, 106, 108-121, 123-126, 129-131, 133, and 134 were rejected under 35 U.S.C. §103(a) as being unpatentable over Henson (U.S. Patent No. 6,167,383) in view of Motomiya (U.S. Patent No. 6,083,267), and further in view of Risk (U.S. Patent No. 5,673,434).

To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. Thus, regarding the 103 rejection, as the Examiner is certainly aware, the showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular... Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The *art* must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight

without an initial suggestion to make the combination. None of the cited references suggests or indicates a motivation to combine, and thus, the § 103 rejection of the independent claims should be withdrawn if for these reasons only.

Additionally, Applicant asserts that the present claims are patentable in light of the following remarks.

Currently amended independent claim 89 recites:

89. (Currently Amended) A method for enabling a user to configure a measurement system in an e-commerce system, wherein the e-commerce system includes a client system coupled through a network to an electronic commerce server, the method comprising:

- receiving a request from a user of the client system to configure the measurement system, wherein the measurement system includes one or more customizable components, wherein at least one of the customizable components is a measurement device;

- providing customizable component options of the customizable components to the client system for display after receiving said request;

- receiving customizable component selections for at least one of the one or more customizable components of the measurement system in response to user input, wherein the customizable component selections applied to the measurement system specify a configured measurement system; and

- providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user.

Henson discloses a method for providing customer configured machines at an Internet site. Henson in the abstract does teach a web-based online store including a configurator, a cart, a checkout, a database, and a user interface enabling a custom

configuration of a computer system. However, Henson does not teach or suggest providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user, as the Examiner had admitted in the Office Action.

The Office Action asserts that a standard personal computer with a speaker is a measurement system. Applicant respectfully suggests that such a computer absent some type of measurement software, such as a measurement application program or instrument driver, and/or measurement hardware, such as a data acquisition (DAQ) expansion card, signal generator, etc., is not properly a measurement system, as would be recognized by those skilled in the art of measurement systems. The cited IEEE Spectrum reference teaches virtual instruments (based on computers). However, Applicant notes that such virtual instruments still require measurement-related software and/or hardware to perform measurement functions. In other words, while a standard personal computer may be used to create or build a measurement system, additional software and/or hardware components specific to the measurement domain are required for the system to be a measurement system.

Applicant notes that even if a user were to use Henson's system to configure a computer system, the configured computer system would not be a configured measurement system, and so additional configuration would still be required, e.g., to add measurement related software and/or hardware. Thus, the problem of configuring a computer system is not the same as that of configuring a measurement system.

Thus, neither Henson nor the IEEE Spectrum reference teaches or suggests online configuration of a measurement system, nor does either reference teach or suggest providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user.

The Office asserts that it would have been obvious to combine the system taught by Motomiya with that of Henson to produce the system described in the present application. Applicant respectfully disagrees.

Applicant notes that Motomiya teaches a method for designing jewelry, such as a necklace or a bracelet. Motomiya teaches display of a multiplicity of photographic images of various jewelry components, from which the user may select desired jewelry components to design a necklace or bracelet.

In column 4, lines 30-44, Motomiya teaches that :

“the material, the color and the length of the equipment, the color of the fasteners and the color of the beads are presented for selection as parts required for designing the necklace or the bracelet.”

In other words, Motomiya teaches selection of accessories for a jewelry item being designed, such as a bracelet or necklace.

The jewelry design taught in Motomiya is significantly different from configuring a measurement system, wherein the measurement system includes one or more customizable components, wherein at least one of the customizable components is a measurement device. Hence Motomiya does not teach nor suggest providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user.

Thus, the Motomiya reference (and the Barad reference, as well) is not analogous art. “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oeticker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Certain of the presented claims are directed at measurement and measurement systems, and the particular problem addressed is the configuration of measurement systems. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically

would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Here, Motomiya (and Barad) is clearly not in the field of Applicants' endeavor. Many of the present claims deal with measurement systems, and the configuration thereof. In contrast, Motomiya deals with jewelry design (and Barad deals with toys). Furthermore, the subject of Motomiya (or Barad) would not logically have commended itself to an inventor's attention when considering the problem addressed by the claimed invention. One of skill in the art seeking to address the problem of configuring measurement systems would not have any logical reasons for considering a technique used to design or configure jewelry (or toys). Thus, Motomiya (and Barad) is not within Applicants' field of endeavor and is not pertinent to the problem addressed by Applicants' invention. Accordingly, Motomiya (and Barad) is non-analogous art and cannot properly be used to reject Applicants' claims.

The Examiner states that online configuration of jewelry (Motomiya) and toys (Barad) is pertinent to the particular problem with which the applicant was concerned, that is, the online configuration of measurement systems. The Examiner has clearly over-generalized the particular problem with which the inventors were concerned. *In re Oeticker* refers to the particular problem, not the general problem. The analogous art requirement can always be made meaningless by over-generalizing the problem. Almost any art may be considered pertinent if the problem is stated in general enough terms. That is why the courts have insisted that art use in § 103 rejections be pertinent to the particular problem. For many of the presented claims, the particular problem with which the inventors were concerned pertains to online configuration of measurement systems. Motomiya (and Barad) is clearly not pertinent to this particular problem.

The Office Action further asserts that Risk teaches "providing text corresponding to the customizable component selections of the user; wherein the text is visually depicted proximate to respective locations of the customizable components comprised in the image of the configured measurement system." Applicant respectfully disagrees.

Applicant notes that Risk teaches a customizable “solid” necktie that may include writing on elements of the tie, and that Risk specifically does not teach online configuration of a measurement system, and in fact, does not teach or describe online configuration at all. Applicant is perplexed by the citation of a possibly lettered or otherwise decorated mechanical necktie with respect to the present case.

As described in the cited passage of Risk (and illustrated in Figure 2), “The adorning characteristic may take the form of a solid color tie of a same or contrasting color as the remainder of the wearer’s apparel. It may also be provided with designs, writing and/or other indicia, *again for adornment purposes* or, in the alternative, for the statement of a message through the design or writing. Such message might be the advocating of a personal position of the wearer, support for an athletic team, an advertisement, or the like.”

In contrast, in this embodiment of Applicants system, the text corresponds to the customizable component selections of the user. In other words, as the specification of the present application makes clear, the text displayed is for identification or description of the customizable components, and is specifically not for adornment on the components themselves, as in the system of Risk.

As per above, Risk is clearly not analogous art, and thus should not have been cited in the 103 rejection.

Thus, Applicant respectfully submits that neither Henson, Motomiya, nor Risk, either singly or in combination, teaches or suggests all the limitations of claim 1. Therefore, for the reasons given above, the cited art cannot be combined to teach the limitations of the presently claimed case. Applicant further submits that Motomiya and Risk are not analogous art, and thus should not be used in the 103 rejection. Similar arguments apply to the 103 rejection of claims 111, 133, and 134.

Thus Applicant respectfully submits that claim 1 of the present application is patentably distinct over the cited references, and thus is allowable. In view of the similarity of claims 111, and 133 to the base claim 1, the arguments advanced above apply with equal force to claims 111, and 133. Applicant further submits that neither

Henson, Motomiya, nor Risk, either singly or in combination, teaches or suggests, the claimed features directed to configuring a computer system in an e-commerce system as claimed in independent claim 134, nor in any of Henson, Motomiya, or Risk is there a motivation to combine, and thus, claim 134 is also patentably distinct over the cited art.

Because claims 90-98, 100-103, 106, 108-109, 112-121, 123-126, and 129-131 depend from independent claims 89 and 111, Applicant submits that these claims are allowable for at least the reasons given above.

The Office Action rejected claims 89-134 under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Barad et al (US 6,206,705 B1, "Barad"), and further in view of Risk and IEEE Spectrum. Applicant respectfully disagrees.

As described above, Henson in view of IEEE Spectrum reference does not teach the limitations of claim 1, and in fact, does not teach or suggest or relate to configuration of a measurement system at all. Applicant notes that the cited IEEE Spectrum article merely describes the use of LabVIEW to implement virtual instruments, as is well known in the art, and specifically does not teach, suggest, or relate to online configuration of measurement systems.

Thus, Henson and the IEEE Spectrum reference do not teach or suggest online configuration of a measurement system, nor do Henson and the IEEE Spectrum reference teach or suggest providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user.

The Office Action asserts that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Barad into the method and system of Henson to produce Applicant's system. Applicant respectfully disagrees.

Barad teaches online configuration of a toy. While Barad does state, "a representational image of the toy incorporating the selected configuration may be displayed" (Abstract), nowhere does Barad teach or suggest configuration and illustration of a measurement system, online or otherwise. More specifically, the toy design taught

in Barad is significantly different from configuring a measurement system, wherein the measurement system includes one or more customizable components, wherein at least one of the customizable components is a measurement device. Hence Barad does not teach nor suggest providing an image of the configured measurement system to the client system for display, wherein the image of the configured measurement system visually depicts the customizable component selections of the user. Additionally, as described above in detail, Barad is not analogous art, and so should not be cited in the 103 rejection.

Thus, neither Henson, Barad, nor the IEEE Spectrum reference, either singly or in combination, teaches or suggests all the limitations of claim 1, and thus claim 1, and claims dependent thereon, is patentably distinct over the cited references, and is thus allowable. Similar arguments apply to independent claims 111, and 133, and so Applicant suggests that these claims, and their respective dependent claims, are similarly patentably distinct over the cited art, and are thus allowable.

Applicant further submits that neither Henson, Barad, nor the IEEE Spectrum reference, either singly or in combination, teaches or suggests the claimed features directed to configuring a computer system in an e-commerce system, as claimed in independent claim 134, , nor in any of Henson, Barad, nor the IEEE Spectrum reference is there a motivation to combine, and thus, Applicant submits that claim 134 is patentably distinct over the cited art, and is thus allowable.

Thus, for at least the reasons given above, removal of the § 103(a) rejection of claims 89-134 is respectfully requested.

CONCLUSION

Rejection of claims 89-134 under 35 U.S.C. § 103(a) have been responded to. This response, therefore, constitutes a complete response to all issues raised in the Office Action mailed September 15, 2003. In view of the remarks traversing the rejections presented in the Office Action, pending claims 89-134 are in condition for allowance.

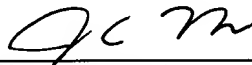
Applicant submits the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5150-40800/JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Replacement Figures 1 and 5
- ☒ Notice of Change of Address

Respectfully submitted,



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